

### **III. REMARKS**

#### **Preliminary Remarks**

Upon entry of the current amendment, claims 7, 9, and 10 will be pending, of which claim 7 is independent. The applicants respectfully request reconsideration and allowance of the present application. Claim 8 is canceled and claim 7 is amended. Support for the claim amendments can be found in the specification as filed (see, for example, the table on page 2). The specification is amended to correct an obvious errors in the citations. Therefore, the applicants believe that no new matter is added.

This response is filed within the shortened statutory period for response. Therefore, the applicants believe that no fee is due.

#### **Patentability Remarks**

##### ***Rejections under the judicially created doctrine of obviousness-type double patenting –***

Claims 7-10 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-7 of Esch *et al.* (U.S. Pat. No. 5,925,708). Claim 8 is canceled and the applicants submit a terminal disclaimer under 37 C.F.R. §1.321 rendering this rejection moot. Therefore, the applicants respectfully request withdrawal of this rejection.

##### ***Rejections under 35 U.S.C. §112 –***

Claims 7-10 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. This rejection is moot in view of the amendments to the claims.

Claim 8 is canceled. Claim 9 is amended to depend from claim 7. Claim 10 is amended to depend from claim 9.

The examiner alleged that the ml cannot be determined unless the NaOH concentration is known and whether that referred to the Sears value. Claim 7 is amended to be directed to, *inter alia*, a vulcanized rubber compound comprising precipitated silica having a Sears value of 6 to 20 ml. Sears value ( $V_2$ ) is the titration volume of KOH consumed while titrating from pH 6 to pH 9. The procedure for determining the Sears value of a silica is detailed in Example 13 on page 16 of the specification as filed. The concentration of KOH is 0.1 N.

The examiner also alleged that  $V_2$  and  $V_1$  were not defined. The ratio  $V_2/V_1$  is a parameter well known to one of ordinary skill in silica chemistry.  $V_2$  is the pore volume of pores that are responsible for elastomer reinforcement (175 Å to 275 Å) while  $V_1$  is the pore volume of pores with a diameter >400 Å. The  $V_2$  in the ratio  $V_2/V_1$  is not the same as the  $V_2$  of the Sears value. The  $V_2/V_1$  ratio is described in detail in EP 0 520 862, which corresponds to U.S. Pat. No. 5,403,570 (see, for example, column 6, lines 36 to 50 and column 13, line 67 to column 14, line 3 of U.S. Pat. No. 5,403,570). EP 0 520 862 is referenced on page 1, paragraph 4 of the specification as filed.

The applicants respectfully submit that claims 7, 9, and 10 are not indefinite under 35 U.S.C. §112, second paragraph, and request removal of this rejection.

In view of the foregoing, the applicants respectfully submit that the claims are now in form for allowance and hereby respectfully solicit such action. If any point remains in issue that the examiner feels may be best resolved through a personal or telephone interview, the examiner is strongly urged to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

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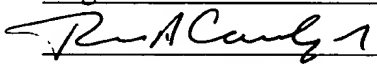
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In making the above disclaimer, petitioner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§154 to 156 and 173 of the patent in line numbered 5 or 6 above, as presently shortened by any terminal disclaimer, of the above-listed patent in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321, has all claims canceled by a reexamination certificate, is reissued, or is otherwise terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

By the enclosed Fee Transmittal, the Patent Office is hereby authorized to charge the fee required under 37 CFR § 1.20(d) to the undersigned's firm's deposit account.

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Attorney of Record:  
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Date: November 10, 2003